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## Trade marks and Designs

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### What does it cover?

- EU trademarks and registered Community designs. The guidance specifically covers EU Regulation established intellectual property rights that grant the holders of such registered trade marks or designs, protection across all EU countries, and trade marks and registered designs held under the Madrid and Hague systems (which allow users to make a single application to protect their design or trade mark by registration in up to 113 countries, which includes the EU and the UK).
- Unregistered Community designs (these are currently governed by an EU regulation, and provide certain design features with a limited period of protection following disclosure to the public in the EU).
- Issues of confidentiality and correspondence addresses for UK trade marks and designs.

### What will happen?

- In the event that the UK leaves the EU without agreement, the government will provide equivalent UK trade mark or design registrations to ensure all existing registered Community designs and registered EU trade marks will continue to be protected and enforceable in the UK. It is worth noting that in 2017, it was estimated that there are over 1.7 million EU trade marks and Community designs in force (as recognised by the guidance note).
- Although no detail is provided on how these equivalent UK registered trade marks or designs are to be provided, the note states that these will be in force at the time of the UK's departure and will be "provided with minimal administrative burden", and will then provide the rights holder with the same protection as if it had been applied for and registered under UK law.
- Any business who was in the process of applying for an EU trade mark or registered Community design, will have a period of nine months from the UK's exit to apply for a UK registered trade mark or design, and can retain the date of their EU application for priority purposes.
- With regard to those trademarks and designs which are protected in the EU under the Madrid and Hague systems, it is currently unclear as to how such protection will be continued in the UK after March 2019, although the note states that the UK is working with the World Intellectual Property Organisation to provide such protection following exit day.

- EU trade marks and Community design registrations will still be open to those UK applicants (just as other third country applicants) who wish to protect their marks or designs through the remaining EU countries.
- With regard to unregistered Community designs, the government states that it will ensure all such existing rights which are protected at the date of exit, will remain enforceable for the remaining period of protection, although no detail has been provided on this at this time.
- The government also intends to create a new supplementary unregistered design right for the UK, mirroring the protections offered by the unregistered Community design system.
- Legislative changes will be made as necessary to ensure that UK unregistered design rights system continues to operate 'effectively'.
- The government will make provision for those registered Community designs, EU trade marks and unregistered Community designs which are the subject of a legal dispute under the UK courts at withdrawal from the EU, but no further detail on this is provided at this time.
- UK legislation provides for legal professional privilege to be given to any communication between registered trade mark attorneys in the UK and their clients (meaning that in legal disputes, such communications are considered confidential). Such privilege is also afforded to certain representatives from within the EEA who are on a defined list for the European Intellectual Property Office. There are no immediate changes to these rules.
- There are no immediate changes to rules for correspondence addresses for service of information with regard to patents and patent applications, and these will not be affected by the UK's withdrawal.

### What will businesses have to do?

- Anyone who holds a registered EU trade mark or Community design, should be notified that a new, equivalent UK protection has been granted. They will then have the opportunity to opt out of such UK right if they wish. The timing of such notification (whether before or after exit from the EU) has not been made clear, and the guidance does not suggest that there will be any additional fee to pay for this equivalent right (although this has not been confirmed).
- Anyone who has a pending application for a registered Community design or EU trade mark will have to **make a new application, and pay all relevant fees**, to the UK Intellectual Property Office for an equivalent right in the UK. It is crucial to note that there will be **no notification** made to such applicants, and the onus will be on those businesses or individuals to take action themselves. Refiled applications in the UK are able to retain their initial EU application date, providing that such applications are made within nine months from the date of exit.
- Anyone (whether UK, EU or third country) who disclosed a design within an EU member state which is protected as an unregistered Community design as at the date of the UK's exit from the EU, will continue to benefit from such protection in the UK under the new supplementary unregistered design right, which will take effect automatically with no need for action by the right holder.
- Existing unregistered Community designs will remain effective across the EU member states.
- The guidance advises that legal advice should be sought on how such changes may affect businesses.
- As the current rules with regards to legal privilege and correspondence addresses will remain unaffected, businesses do not need to consider any immediate implications.

*This Technical Notice was compiled with the kind assistance of the law firm Squire Patton Boggs, who are working with a number of businesses in the UK and internationally on their preparations for Brexit, and can be contacted via [jeremy.cape@squirepb.com](mailto:jeremy.cape@squirepb.com)*

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